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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,582	11/16/2001	Stephen M. Hitchen	7216-1	8250
7590	06/15/2005		EXAMINER	
Steven M. Greenberg Esq CHRISTOPHER & WEISBERG PA 200 East Las Olas Boulevard Suite 2040 Fort Lauderdale, FL 33301			WASSUM, LUKE S	
			ART UNIT	PAPER NUMBER
			2167	
DATE MAILED: 06/15/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/992,582

Applicant(s)

HITCHEN ET AL.

Examiner

Luke S. Wassum

Art Unit

2167

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply****A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 22 April 2005.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 16 November 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

1. The Applicants' amendment, filed 22 April 2005, has been received, entered into the record, and considered.
2. As a result of the amendment, claims 3 and 15 have been amended. Claims 1-20 remain pending in the application.

### *The Invention*

3. The claimed invention is a collaborative rights management system for distributing documents with digital rights management data appended, thus preserving the integrity of the documents by enforcing specific digital rights on a user-by-user basis.

### *Claim Objections*

4. In view of the Applicants' amendments to claims 3 and 15, the examiner withdraws the pending claim objections.

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morinaga et al. (U.S. Patent 5,724,578) in view of McCurdy et al. (U.S. Patent Application Publication 2002/0035697).

9. Regarding claim 1, **Morinaga et al.** teaches a collaborative file rights management method as claimed, comprising:

- a) identifying a file input/output (I/O) request to access a file, said file I/O request originating in an authoring application (see col. 4, lines 20-23, disclosing that all requests for files are received by the file transaction control unit);
- b) suppressing said file I/O request (see col. 4, lines 24-28, disclosing that file operation control unit);
- c) automatically extracting digital rights management data appended to said file (see disclosure of the file control block, col. 4, lines 32-61); and
- d) providing said file to said authoring application (see col. 4, lines 32-38; see also col. 7, lines 35-46).

**Morinaga et al.** does not explicitly teach a collaborative file rights management method including the step of managing access to said file in said authoring application based upon said extracted digital rights management data.

**McCurdy et al.**, however, teaches a collaborative file rights management method including managing access to said file in said authoring application based upon said extracted digital rights management data (see paragraphs [0137] through [0140]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to perform the claimed intercepting, detecting and quashing steps in cooperation with an authoring application, since digital rights management dictates that users with no rights to individual parts of a

document be prohibited from copying not only an entire document, but the individual protected parts (see paragraphs [0137] and [0138]).

10. Regarding claim 9, **Morinaga et al.** teaches a collaborative file rights management method as claimed, comprising:

- a) identifying a file input/output (I/O) request to save a file, said file I/O request originating in an authoring application (see col. 4, lines 20-23, disclosing that all requests for files are received by the file transaction control unit);
- b) suppressing said file I/O request (see col. 4, lines 24-28, disclosing that file operation control unit);
- c) appending digital rights management to said file (see disclosure of the file control block, col. 4, lines 32-61); and
- d) storing said file in fixed storage (see col. 4, lines 44-61; see also col. 7, lines 61-65).

**Morinaga et al.** does not explicitly teach a collaborative file rights management method including the step of automatically encrypting the file.

**McCurdy et al.**, however, teaches a collaborative file rights management method including the step of automatically encrypting the file (see paragraph [0016]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to automatically encrypt a saved file, since encryption is a well known and widely used technique for protecting data and/or files from access by unauthorized users.

11. Regarding claim 12, **Morinaga et al.** teaches a collaborative file rights management system as claimed, comprising:

- a) a file security management application configured to intercept operating system messages directed to an authoring application (see col. 4, lines 20-23, disclosing that all requests for files are received by the file transaction control unit);
- b) a file security filter driver configured to identify file input/output (I/O) requests received in a kernel-layer system manager to open a file in said authoring application (see col. 4, lines 32-38; see also col. 7, lines 35-46);
- c) said file security driver quashing said file I/O requests and providing said file to said authoring application (see col. 4, lines 32-38; see also col. 7, lines 35-46);
- d) said file security management application extracting digital rights management data appended to said file, detecting among intercepted operating system messages operating system messages directed to authoring applications which can be limited according to digital rights specified in said extracted digital rights management data and quashing said detected events where said digital rights management data prohibits execution of said authoring application operations (see disclosure of the file control block, col. 4, lines 32-61; see also col. 8, lines 10-16).

**Morinaga et al.** does not explicitly teach a collaborative file rights management system including the automatic encryption and decryption of the file.

**McCurdy et al.**, however, teaches a collaborative file rights management method further comprising automatically encrypting said file (see paragraph [0016]) and decrypting said file (see paragraph [0205]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to automatically decrypt a retrieved file, since encryption/decryption is a well known and widely used technique for protecting data and/or files from access by unauthorized users, and decryption is necessary for an authorized user to access an encrypted file.

12. Regarding claim 13, **Morinaga et al.** teaches a machine readable storage having stored thereon a computer program for managing digital rights in a collaborative file, said computer program comprising a routine set of instructions for causing the machine to perform the steps of:

- a) identifying a file input/output (I/O) request to access a file, said file I/O request originating in an authoring application (see col. 4, lines 20-23, disclosing that all requests for files are received by the file transaction control unit);
- b) suppressing said file I/O request (see col. 4, lines 24-28, disclosing that file operation control unit);
- c) automatically extracting digital rights management data appended to said file (see disclosure of the file control block, col. 4, lines 32-61); and

d) providing said file to said authoring application (see col. 4, lines 32-38; see also col. 7, lines 35-46).

**Morinaga et al.** does not explicitly teach a computer program for managing digital rights including the step of managing access to said file in said authoring application based upon said extracted digital rights management data.

**McCurdy et al.**, however, teaches a computer program for managing digital rights including managing access to said file in said authoring application based upon said extracted digital rights management data (see paragraphs [0137] through [0140]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to perform the claimed intercepting, detecting and quashing steps in cooperation with an authoring application, since digital rights management dictates that users with no rights to individual parts of a document be prohibited from copying not only an entire document, but the individual protected parts (see paragraphs [0137] and [0138]).

13. Regarding claims 2 and 14, **McCurdy et al.**, however, teaches a collaborative file rights management method and computer program for managing digital rights further comprising decrypting said file (see paragraph [0205]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to automatically decrypt a retrieved file, since encryption/decryption is a well known and widely used technique for protecting data and/or files from access by unauthorized users, and decryption is necessary for an authorized user to access an encrypted file.

14. Regarding claims 3 and 15, **Morinaga et al.** additionally teaches a collaborative file rights management method and computer program for managing digital rights wherein said extracting step further comprises:

- a) determining environmental data associated with said I/O request, said environmental data comprising at least one of a requestor's identity, a requestor's class, a requestor's computing domain, a requestor's location, a password, a time of day, and a date (see registration of the requestor's identity, col. 7, lines 16-21; see also col. 7, lines 35-46); and extracting an access policy appended to said file (see file control block in Figure 3A, including access rights based upon the specific requestor's identity).

15. Regarding claims 4 and 16, **Morinaga et al.** additionally teaches a collaborative file rights management method and computer program for managing digital rights wherein said providing step further comprises:

- a) comparing said access policy to at least a portion of said environmental data (see col. 4, lines 32-62; see also col. 7, lines 35-46);
- b) authenticating said file I/O request based upon said comparison (see col. 4, lines 32-62; see also col. 7, lines 35-46); and

c) providing said file to said authoring application only if said I/O request has been authenticated (see col. 4, lines 32-62; see also col. 7, lines 35-46).

16. Regarding claims 5, 10 and 17, **Morinaga et al.** additionally teaches a collaborative file rights management method and computer program for managing digital rights wherein said suppressing step further comprises:

- a) posting a responsive message to said authoring application (see col. 8, lines 10-16);
- b) intercepting an operating system event in said authoring application, said operating system event indicating receipt of said responsive message (see col. 8, lines 10-16); and
- c) quashing further processing of said intercepted operating system event (see col. 8, lines 10-16).

17. Regarding claims 6, 11 and 18, **Morinaga et al.** additionally teaches a collaborative file rights management method and computer program for managing digital rights wherein said identifying step comprises:

- a) monitoring kernel-level file I/O requests contained in I/O request packets processed in a file system manager (see col. 4, lines 20-28); and
- b) detecting said file I/O request to access said file in one of said I/O request packets (see col. 4, lines 20-28).

18. Regarding claims 7, 8, 19 and 20, **Morinaga et al.** teaches a collaborative file rights management method and computer program for managing digital rights substantially as claimed.

**Morinaga et al.** does not explicitly teach a collaborative file rights management method and computer program for managing digital rights wherein said management step comprises the claimed intercepting, detecting and quashing steps in cooperation with an authoring application wherein the protected operations are selected from clipboard operations, printing operations, file saving operations and file editing operations.

**McCurdy et al.**, however, teaches a collaborative file rights management method and computer program for managing digital rights wherein said management step comprises:

- a) intercepting operating system messages in said authoring application (see paragraphs [0137] through [0140]);
- b) detecting among said intercepted operating system messages, operating system messages directed to authoring application operations which can be limited according to digital rights specified in said extracted digital rights management data, wherein the protected operations are selected from clipboard operations, printing operations, file saving operations and file editing operations (see paragraphs [0137] through [0140]); and
- c) quashing said detected events where said digital rights management data prohibits execution of said authoring application operations (see paragraphs [0137] through [0140]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to perform the claimed intercepting, detecting and quashing steps in cooperation with an authoring application, since digital rights management dictates that users with no rights to individual parts of a

document be prohibited from copying not only an entire document, but the individual protected parts (see paragraphs [0137] and [0138]).

*Response to Arguments*

19. Applicant's arguments filed 22 April 2005 have been fully considered but they are not persuasive.

20. Regarding the Applicants' argument that "the cited portion of Morinaga wholly lacks any reference to the interception and processing of file I/O requests as explicitly recited in all of the independent claims" (Applicants' remarks, page 11, last paragraph), the examiner respectfully disagrees.

21. At col. 4, lines 19-28, **Morinaga et al.** discloses a control unit 12, comprising a transaction control unit which receives all requests for operating files input by users, and a file operation control unit which processes the files in accordance with the requests received by the transaction control unit. This control unit anticipates the Applicants' claimed limitation of identifying file I/O requests to access a file.

22. The reference further discloses that the file operation control unit comprises, *inter alia*, an access right control unit which extracts a file control block from the file, and examines said file control block to determine file access rights (including a visible right, a reading right, a writing right, a copying right, a deleting right and an owner right, collectively analogous to the claimed digital

rights) of each user and the file creator, in order to determine whether or not to grant the user request (col. 4, lines 30-61), a disclosure that anticipates the claimed limitations of suppressing the file I/O request, extracting digital rights management data appended to the file, and managing access to said file based upon the extracted digital rights management data.

23. Regarding the Applicants' argument that there is no motivation to combine the references found within the references themselves, the examiner points out that it is well-settled law that evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See *In re Dembicak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In this case, motivation to combine is derived from the desirability to maintain digital rights management in the context of collaborative authoring applications, said desirability being no different than the desirability to maintain digital rights management in any environment: because it allows document authors/owners to maintain control over the disposition of their writings.

### *Conclusion*

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on

the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 571-273-4119.

Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100, or fax (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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lsw  
10 June 2005